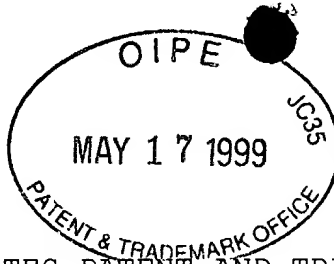


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of ) BEFORE THE BOARD OF PATENT  
Peter FIELD et al. ) APPEALS AND INTERFERENCES  
Serial No. 08/800,742 ) Appeal No.:  
Filed: February 14, 1997 ) Examiner: Darnell M. Boucher  
For: ELECTROMECHANICAL ) Group Art Unit: 3627  
CYLINDER LOCK ) Monday, May 17, 1999

REPLY BRIEF

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GROUP 3600

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

This is a reply under 37 CFR § 1.193(b)(1) to the Examiner's Answer dated March 15, 1999.

At page 3, the Examiner disagrees with appellants that there is no motivation to modify the prior art to arrive at the claimed invention, and asserts as such motivation that Aston teaches that a Nitinol actuator is functionally equivalent to a solenoid actuator. Contrary to arriving at the claimed invention, this disclosure in Aston results in the structure as shown in Fig. 4 (as contrasted with Fig. 1 using a solenoid).

The Examiner then asserts that the Gokcebay reference "teaches that it is well within the skill level of the person of

ordinary skill to mount a solenoid actuator within the plug of the cylinder." Thus, the Examiner's conclusion of obviousness appears to rest upon the erroneous belief that because one of ordinary skill in the art may have been able to arrive at appellants' invention, it would have been obvious. This erroneous belief is further demonstrated by the Examiner's statement that

[t]he Examiner maintains that the person of ordinary skill would know how to make the mechanism of Aston small enough that it could be incorporated into the plug of the key lock in the same manner as that set forth by Gokcebay et al.

Thus, while it is alleged in the Examiner's Answer that those skilled in the art "would know how" to make the claimed invention and that the claimed invention "could be" incorporated into the Aston device, there is no showing or even an allegation anywhere in the Answer that there exists in the prior art any reason or motivation for one of ordinary skill in the art to have made the claimed invention.

As correctly stated at page 4 of the Answer, the question to be answered in determining obviousness is what the combined teachings of the prior art would have suggested to those of ordinary skill in the art. The Answer appears to have confused this question with what the person of ordinary skill would be able to do. As explained in appellants' main brief, the flaw in the rejection of the claims on appeal is the absence of any

expressed reason, suggestion or motivation for the person of ordinary skill in the art to have made the proposed combination.

**CONCLUSION**

In view of the foregoing and the arguments in the main brief filed March 1, 1999, the Honorable Board is requested to reverse all grounds of rejection and to direct the passage of this application to issue.

Respectfully submitted,

ROTHWELL, FIGG, ERNST & KURZ, p.c.

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